

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte: STEFAN PARKVALL, P&L FRENGER AND  
ERIK DAHLMAN

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Application No. 09/742,283

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received at the Board of Patent Appeals and Interferences on September 20, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

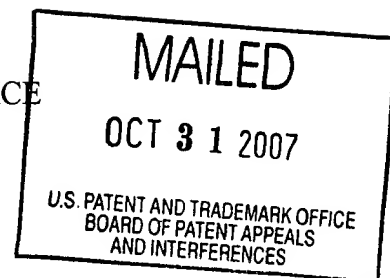
**APPEAL BRIEF**

Appellant filed an Appeal Brief dated February 8, 2007, in response to the Notification of Non-Compliant Appeal Brief mailed February 1, 2007. The Appeal Brief is not in compliance with the new rules of 37 CFR § 41.37(c) effective September 13, 2004.

**Status of Claims**

The "Status of Claims" section does not properly identify the appealed claims.  
37 CFR § 41.37(c)(iii) states:

(iii) *Status of claims*. A statement of the status of all the claims in the proceeding (e.g.,



rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed.

### **Summary Of Claimed Subject Matter**

Appellant filed an Appeal Brief dated February 8, 2007, in response to the Notification of Non-Compliant Appeal Brief mailed February 1, 2007. The Appeal Brief is not in compliance with the new rules of 37 CFR § 41.37(c) effective September 13, 2004. § 37 CFR § 41.37(c)(v) states:

**(v) *Summary Of Claimed Subject Matter.*** A concise statement of each ground of rejection presented for review.

An in-depth review of the Appeal Brief indicates that the following sections are missing from the Appeal Brief. The Appeal Brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claims argued separately, every means plus functions and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with references to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).

The “Summary of Claimed Subject Matter” appearing on pages 3-7 of the Appeal Brief filed February 8, 2007, is deficient because it does not separately map independent claims 1, 14, 26 and 39 to the specification.

### **Grounds of Rejection to be Reviewed on Appeal**

The “Grounds of Rejection to be Reviewed on Appeal” section of the brief is found to be defective. The 103(a) statute used in the Final Rejection mailed March 21, 2006 must be

included in the statement or rejections in the brief. 37 CFR 41.37(c)(1)(vi) states:

**(vi) *Grounds of rejection to be reviewed on appeal.*** A concise statement of each ground of rejection presented for review. For example, the statement “Whether claims 1 and 2 are unpatentable” would not comply with the rule, while the statements “Whether claims 1 and 2 are unpatentable under 35 U.S.C. 103 over Smith in view of Jones,” and “Whether claims 1 and 2 are unpatentable under 35 U.S.C. 112, first paragraph, as being based on a nonenabling disclosure” would comply with the rule. The statement cannot include any argument concerning the merits of the ground of rejection presented for review. Arguments should be included in the “Argument” section of the brief.

### **Argument**

Each grounds of rejected on appeal must be argued separately in the Arguments section of the brief. 37 CFR 41.37(c)(1)(vii) states:

**(vii) *Argument.*** The appellant’s contentions with respect to each ground of rejection presented and the basis for those contentions, including citations of authorities, statutes, and parts of the record relied on, should be presented in this section. A statement which merely points out what a claim recites will not be considered an argument for patentability of the claim. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. The failure of appellant to separately argue claims which appellant has grouped together constitutes a waiver of any argument that the Board must consider the patentability of any grouped claim separately. See *In re McDaniel*, 293 F.3d 1379, 1384, 63 USPQ2d 1462, 1465-66 (Fed. Cir. 2002). Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number.


**CONCLUSION**

Accordingly, it is

ORDERED that the application is returned to the  
examiner to:

- (1) hold the Appeal Brief filed on February 8, 2007 defective;
- (2) to notify appellants to file a substitute Appeal Brief in compliance with 37 CFR § 41.37(c);
- (3) for the examiner to consider the substitute Appeal Brief filed by appellants; and
- (4) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

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PJN/tsj

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